

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/748,716 Confirmation No. 5358
Applicant : Sara Elo DEAN et al.
Filed : December 22, 2000
TC/A.U. : 2173
Examiner : Dennis G. BONSHOCK
Docket No. : POU920000205US1
Customer No. : 23334

VIA FACSIMILE (703) 872-9306

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450
Attention: Examiner Dennis G. BONSHOCK

RESPONSE UNDER 37 C.F.R. § 1.111

Sir:

The following Response is being submitted in response to the non-final Office Action dated March 30, 2006. Please consider the following remarks.

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date _____, 2004 By: _____

Signature: _____
Applicant, Assignee, or Representative

REMARKS

Applicants have studied the Office Action dated March 30, 2006. It is submitted that the application is in condition for allowance. Claims 1-39 are pending. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

In the Office Action, the Examiner:

- rejected the affidavit under 37 C.F.R. § 1.131 submitted by the Applicants on July 21, 2005;
- rejected claims 1-9, 11-31, and 33-39 under 35 U.S.C. §102(e) as being anticipated by Carroll, Jr. (U.S. Patent Application Number 2002/0085020); and
- rejected claims 10 and 32 under 35 U.S.C. §103(a) as being unpatentable over Carroll, Jr. (U.S. Patent Publication Number 2002/0085020) in view of Stapel et al. (U.S. Patent Publication Number 2002/0087571).

1.131 Affidavit

As noted above, the Examiner rejected claims 1-9, 11-31, and 33-39 under 35 U.S.C. §102(e) as being anticipated by Carroll, Jr. (U.S. Patent Application Number 2002/0085020) and rejected claims 10 and 32 under 35 U.S.C. §103(a) as being unpatentable over Carroll, Jr. (U.S. Patent Publication Number 2002/0085020) in view of Stapel et al. (U.S. Patent Publication Number 2002/0087571).

On January 12, 2006, the Applicants submitted an affidavit under 37 CFR 1.131 to overcome the Carroll reference. The Examiner rejected the submitted affidavit for "fail[ing] to meet all requirements for filing an affidavit or declaration as specified in MPEP 715.07."

Specifically, the Examiner correctly pointed out that page 3 of Exhibit A, which was referred to by Applicants as showing evidence that the present invention was conceived and reduced to practice prior to the effective date of Carroll, is a blank page. The reference to Exhibit A in the previously submitted affidavit under 37CFR § 1.131 was a typographical error. The reference should have been made to Exhibit B. The affidavit

has now been corrected to indicate that the limitation of “receiving a user selection for a document type” is shown in Exhibit B, page 3, step 2.3, which describes the step of creating the appropriate fragment.

Additionally, the Examiner stated that, with respect to the 4 separate screen shots in Exhibit I, “none of which show an assembling of user interface controls so that the editor is a [sic] ‘free from [sic] specific document type definition syntax’.” Applicants respectfully disagree with the Examiner’s conclusion.

In fact, the first screen capture in Exhibit I is exactly represented in FIG. 8 and described on page 23 of the instant application, as originally filed. As stated on page 23, “It is important to note that in both FIGs. 8 and 9, the specific syntax of XML is hidden from the user/editor thus simplifying the interface.” With respect to the Examiner’s objection, Applicants submit that it is not possible to show with any more clarity, that which is purposely not present in the screenshot, specifically, the syntax of XML. Going further, on page 18 of the instant specification, it is explained that “In this present invention, the term ‘interface controls’ ... is used to describe an element of a GUI 702 that displays information or provides a specific way for a user to interact with the operating system and application.” Accordingly, as described on page 22 of the instant application, the right panel 820 of FIG. 8 is an editor pane editing a specific image fragment. As a result, FIG. 8, and therefore the screenshot of Exhibit I, show a UI editor with one or more interface controls so that the presentation of the UI editor is free from specific document type definition syntax.

Further, over 100 pages of evidence with test results corroborating the reduction to practice has been submitted. The Applicants note that this identical evidence was deemed more than sufficient in the co-pending U.S. Patent Application Serial No. 09/747,871 (the ‘871 Application) entitled “Method And Apparatus For End-To-End Content Publishing System Using XML with An Object Dependency Graph” with inventors Peter E. Davis, Sara Elo Dean, Dikran S. Meliksetian, Jeffery Milton, Louis Weitzman, and Nianjun Zhou to swear behind a reference and thereby result in the allowance of the ‘871 Application. The present invention was filed on December 22,

2000 the same date as the '871 Application. The three inventors of the present invention are co-inventors on the '871 Application and the present invention '871 are commonly assigned to International Business Machines Corporation.

Accordingly, Applicants hereby submit a new affidavit under 37CFR § 1.131, which corrects the typographical error in the previously submitted affidavit and states and includes evidence that the present invention was conceived and reduced to practice prior to the effective date of Carroll. Applicants submit that Carroll is now removed as a reference under 35 U.S.C. 102 and 103.

Rejection under 35 U.S.C. §102(e) as anticipated by Carroll

The Examiner rejected claims 1-9, 11-31, and 33-39 under 35 U.S.C. §102(e) as being anticipated by Carroll, Jr. (U.S. Patent Publication Number 2002/0085020). As noted above, Applicants have submitted herewith a properly executed 1.131 Affidavit with relevant evidence herewith to remove the Carroll reference. Accordingly, Applicants respectfully submit that the present invention distinguishes over Carroll for at least this reason and that the Examiner's rejection should be respectfully withdrawn.

Rejection under 35 U.S.C. §103(a) over Carroll and Stapel

As noted above, the Examiner rejected claims 10 and 32 under 35 U.S.C. §103(a) as being unpatentable over Carroll, Jr. (U.S. Patent Publication Number 2002/0085020) in view of Stapel et al. (U.S. Patent Publication Number 2002/0087571). Applicants have submitted herewith a properly executed 1.131 Affidavit with relevant evidence herewith to remove the Carroll reference. Accordingly, Applicants respectfully submit that the present invention distinguishes over Carroll taken alone and/or in view of Stapel for at least this reason and that the Examiner's rejection should be respectfully withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful

clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.


Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

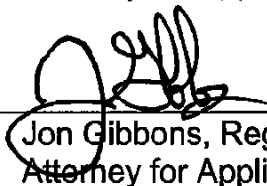
Date: May 17, 2006

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